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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,886	04/16/2001	Hideki Umeyama	TAN-285	5674

7590 04/24/2003

SHERMAN & SHALLOWAY
413 North Washington Street
Alexandria, VA 22314

EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,886

Applicant(s)

UMEYAMA ET AL.

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Objections

1. Claims 2 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. While applicant attempted to cancel these claims when rewriting the subject matter into independent claims 1 and 3, the clean copy of the claims in Appendix D, which is the official amendment entered into the file, did not include a cancellation of the claims. Applicant is required to cancel the claims.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiura in view of Wilder. Sugiura discloses a model of an eye with cataract comprising a pig's eye which has hardening chemicals injected into the lens to form the model. Sugiura does not disclose the injection of a self-hardening chemical selected from the group listed in claim 1 into an empty lens. Wilder discloses that dibenzylidene sorbitol is a self-hardening chemical which forms

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three dimensional fibrillar networks without the need to interact chemically with other substances. It would have been obvious to one of ordinary skill in the relevant art to modify the model disclosed by Sugiura by injecting dibenzylidene sorbitol into an empty lens for the purpose of hardening the eye to produce a simulated cataract without requiring injection into an existing lens. Also, although the location of the injection of claim 5 is not explicitly disclosed by Sugiura, the claimed location does not appear to yield any unexpected advantages over the location disclosed by Sugiura, and thus would also have been obvious to one of ordinary skill in the art as an aesthetic choice of design. Dibenzylidene sorbitol is a known gelling agent which forms three dimensional fibrillar networks in organic substances, as disclosed by Wilder. It would have been obvious to one of ordinary skill in the relevant art to modify the model disclosed by Creating Cataract by providing dibenzylidene sorbitol for the purpose of hardening the eye to produce a simulated cataract.

Response to Arguments

4. Applicant's arguments filed on January 30, 2003 have been fully considered but they are not persuasive. Wilder discloses the pertinent properties of dibenzylidene sorbitol, and further discloses various advantages thereof, including the ability to self-harden into a polymeric substance without requiring injection into an existing lens, such as that disclosed by Sugiura. One of ordinary skill in the relevant art would be familiar with different types of hardening chemicals, and thus would have knowledge of the properties of dibenzylidene sorbitol. The two references,

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when viewed in combination, suggest the present invention. To be clear, the injection of the chemicals into an empty lens is not considered to be an aesthetic choice of design. That rejection has been made only with regards to the location of the injection as claimed in claim 5, which, as stated above, would have been an obvious location to inject the chemicals from to one of ordinary skill in the art.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303.

KF

April 17, 2003


Kurt Fernstrom